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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,456	04/02/2004	Geoffrey B. Rhoads	P0965	1643
23735	7590	07/13/2007		
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			EXAMINER LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	
			MAIL DATE	DELIVERY MODE
			07/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,456

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,11,18,21 and 23-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14,23,34-36 and 41-43 is/are allowed.
- 6) ☒ Claim(s) 5,11,18,21,24,26-33,37-40 and 44-47 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of amendments/arguments filed on 3/22/2007.
2. Claims 5, 11, 14, 18, 21, and 23-47 are presented for examination.
3. This application is a CON of 10/717,211 filed on 11/18/2003 now ABN, which is a CON of 09/342,688 filed on 06/29/1999 now PAT 6,650,761, which is a CIP of 09/314,648 filed on 5/19/1999 now PAT 6,681,028 and claims benefits of 60/134,782 filed on 05/19/1999.

Examiner's Remarks

The italicized sections represent the examiner's interpretation {whether it is direct, broadly or by definition} of each particular claimed limitations and reference points with regards to the prior art of record. After carefully reviewing the previous Office Action and the appellant's arguments, the examiner now applies a broader interpretation of the claims 5, 11, 14, 18, 21, and 23-47 taking into consideration Durst JR. et al. (US 2001/0011276) teaches claimed subject matter. The examiner regrets any inconvenience to the applicant. Accordingly, **the PROSECUTION IS HEREBY REOPENED**. A new ground of rejection is set forth below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 5, 11, 18, 21, 24, 26-33, 37-40, are 44-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Durst JR. et al. (US 2001/0011276).

Re claim 5: Durst JR. et al. {hereinafter referred as "Durst"} discloses scanner enhanced remote control unit and system for automatically linking to on-line resources, which includes:

- means of using a handheld appliance {*herein interpreted as the remote control unit 10*}, receiving machine-readable digital {*herein bar code symbol 12 via the scanning system 16*} data from the poster {*herein interpreted as the printed intelligent document 14; see paragraphs 37-38; 43-48*}, the data being in addition to the visible information {*herein the printed document along document with text or graphics*} (paragraphs 49-53, 67);
- by reference to the machine-readable received from the poster 14 {*by definition a large piece of printed paper with both textual and graphics elements used for advertisement purposes; also disclosed by Durst as printed on the document along with text or graphics. The document may be an advertisement in the form of a magazine insert or page, a brochure, or a television schedule book*}, establishing a link to a remote computer (paragraphs 49-50; 71-72; 118-119);
- wherein the appliance [herein the control 10] includes an output device {*herein Durst discloses input/output ports 28 also provide data and control signal interfaces between the*

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control, recognition and decision logic block 30, the scanning system control interface 26 and the transmission control interface 36, and further the examiner broadly interprets the output device as means of transmitting and/or presenting a signal and/or data to a remote device either through a display or printing means, wherein Durst discloses that the retrieved or generated information is then formatted for transmission to the user computer means and transmitted using appropriate protocols (e.g. TCP/IP) in step 19. This information is then displayed to the user on the television screen and a screen dialog between the user and the information system proceeds; see paragraph 80}, and the method includes presenting information to a user based on data obtained from said remote computer using said output device (see paragraphs 89, 93, 103, 114).

Re claims 11 and 24: Durst further teaches, in addition to the limitations presented above in claim 5, that the method includes communicating over the link to cause electronic content to be transferred, the electronic content comprises a song {*herein Durst discloses that the source identification information is optionally collected for subsequent analysis and the specific on-line resource corresponding to the address and access information encoded on the document is then retrieved and displayed to the user, wherein a direct and efficient link between printed media and on-line resources are potentially limitless includes sporting events, travel show, education show and commercial purchase of books and compact discs, which may be includes a song, a video, a movie and the like*} (see paragraphs 118-130).

Re claim 18: Durst further teaches, in addition to the limitations presented above in claim 5, means of determining, at the remote database {*herein a local database 18 or an activity database 24 on the host computer; see paragraphs 80-81*}, a URL corresponding to the

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machine-readable data, and transmitting data identifying the URL to the appliance; and at the appliance, fetching information from the URL (paragraph 50-54; 62-63).

Re claim 21: Durst further discloses, in addition to the limitations presented above in claim 5, that the digital data comprises first and second data fields *{herein Durst discloses access on-line resources for which address/IP address and access information, such as file ID and source ID, is contained in the machine readable symbol 12, see paragraph 47}*, one of the fields serving to identify an internet address, and a second of the fields serving to convey identification data that can be passed to the internet address to elicit a response corresponding to the poster (see paragraphs 63, 69-83).

Re claims 26, 30, 37, 44: Durst further teaches a system and method, wherein the machine-readable digital data is electromagnetically *{herein using IR signal to read the data from the tag}*, and not optically, received from the poster (paragraphs 44-47, 106-107).

Re claims 27, 31, 38, 45: Durst further discloses a system and method, wherein said appliance includes functions of both a palmtop computer and a digital camera, and the method includes - under control of a user of the appliance - snapping *{herein Durst discloses a flying spot scanner, also the scanning system 16 comprises a linear, one-dimensional array of Charge Coupled Devices (CCD) which is capable of electronically scanning both one-dimensional bar codes and two-dimensional bar codes (by manually sweeping the linear CCD array over the bar code, see paragraphs 41, 87}* an image of the poster, from which image the digital data is then decoded (paragraphs 95-96).

Re claims 28-29, 32-33, 39-40, and 46-47: Durst further teaches a system and method, that includes presenting plural options from which a user can select a desired follow-up action,

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the plural options depending on the digital data, and in which the options include plural of the following actions: linking to a fan web site, downloading audio to the appliance, requesting electronic content to be downloaded to a storage site distinct from the appliance, and ordering {*herein Durst discloses option of ordering or purchasing an item, such as a book, compact discs, video recordings, advanced tickets, contact information regarding fan clubs and the like, in relation to scanning a machine-readable data from the poster*} physical media on which electronic content is stored (paragraphs 52, 57, 122-128).

Allowable Subject Matter

6. Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 14, 23, 34-36, 41-43 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, taken alone or in combination with any other references, fails to teach means of printing the machine-readable digital data that includes a plural-bit code steganographically encoded in artwork printed on the poster. These limitations in conjunction with other limitations in the claimed invention were not shown by the prior art of record.

Response to Arguments

8. Applicant's arguments with respect to claims 5, 11, 14, 18, 21, and 23-47 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

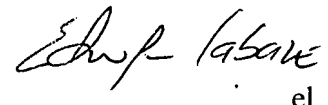
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carro et al. (US 2006/0167754) discloses system and method for selecting, ordering and accessing copyrighted information from physical documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Edwyn Labaze
Patent Examiner
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July 6, 2007